UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KEVIN J. ZILKA and DOMINIC M. KOTAB

Appeal No. 2006-1060
Application No. 10/691,060

ON BRIEF

Before OWENS, LEVY, and NAPPI, *Administrative Patent Judges*

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-4, 7-17 and 20-41. Claim 24 is canceled in the reply brief (page 6).[1]

THE INVENTION

The appellants claim a method for preselecting an identifier and automatically correlating with it content associated with at least one uniform resource locator. Claim 1 is illustrative:

[1] Whether or not the cancelation of claim 24 in the reply brief has been submitted in a separate paper and entered, we consider the appellants' cancelation of claim 24 to be a withdrawal of the appeal as to that claim.

1. A computer-implemented identifier pre-selection method for use in association with a network browser, comprising:

in association with a network browser for browsing content on a network including the Internet, displaying a plurality of identifiers adjacent to a window in which content associated with uniform resource locators (URLs) is displayed, utilizing a processor coupled to memory;

allowing a user to pre-select one of the identifiers; and thereafter,

displaying the content associated with at least one URL utilizing the network browser, and

storing selected displayed content and correlating the content with the pre-selected identifier;

wherein any content selected during use of the network browser results in automatic correlation of the content with the pre-selected identifier.

THE REFERENCE

Rivette et al. (Rivette) 2003/0046307 Mar. 06, 2003

THE REJECTION

Claims 1-4, 7-9, 12, 14-17 and 20-23 and 25-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rivette.

OPINION

We affirm the aforementioned rejection. We address the claims separately to the extent justified by the appellants'

arguments, see 37 CFR § 41.37(c)(1)(vii)(2004), and we incorporate herein the explanations of the rejections and the responses to the appellants' arguments in the examiner's answer.

The appellants argue that the examiner is inconsistent in relying upon both Rivette's display of patent numbers and notes as being content, and that the notes are not associated with a URL (reply brief, pages 12-20). Rivette's patent numbers are identifiers as that term is used by the appellants (specification, page 8, line 12). In Rivette's figure 148, the patent numbers are hyperlinks correlated with the content displayed to the right of the hyperlinks. Hence, Rivette meets the appellants' claim requirement for preselecting an identifier and thereafter displaying, using a network browser, content that is associated with at least one URL and is correlated with the identifier.

The appellants argue that their term "identifier" should not be limited to a patent number (reply brief, pages 21-23), which is correct. However, as pointed out above, that term includes patent numbers.

The appellants argue that their term "preselect" is not limited to selecting an existing identifier (reply brief,

page 24), which is correct. That term, however, includes selecting an existing identifier such as Rivette's patent numbers.

The appellants argue that claim 26 requires extracting a plurality of terms from a claim, and not merely receiving the terms from an operator (reply brief, page 25). The claim includes extraction of a plurality of terms from a claim by an operator.

Regarding claims 29 and 30 the appellants argue that Rivette does not disclose identifying noun or verb terms of the claim (reply brief, page 26). Claim 26, from which claims 29 and 30 depend, requires that a search is capable of being performed, and that the search includes extracting a plurality of terms from the claim. The extraction necessarily encompasses identification of any of the terms in the claim, including the nouns and verbs.

As for claims 33 and 34, the appellants argue that Rivette's disclosure of selecting search terms using a thesaurus is not a disclosure of identifying synonyms based on the terms of the claim and incorporating the synonyms with claim terms (reply brief, page 27). Rivette's disclosure of search strategies

including, but not limited to, keyword phrases with thesaurus (0395), is a disclosure of a search that incorporates keywords, i.e., claim terms, and synonyms, i.e., thesaurus terms.

With respect to claim 36, the appellants argue that removing the word "claim" from the terms of a claim is not the same as excluding "claim" from an operator's search (reply brief, page 27). The appellants have not pointed out, and it is not apparent, how their term "removed", with respect to possible search terms, differs from "excluded" in that context.

The appellants argue, regarding claims 40 and 41, that Rivette's disclosure that a user is enabled to manipulate and process search results (0396) is not a disclosure of modifying terms based on results and user input (reply brief, page 28). Rivette's disclosure that new search criteria can be added to the search criteria in a prior search (0397) is a disclosure of modifying the terms of the search based on the results of the search and user input.

For the above reasons we are not convinced of reversible error in the examiner's rejection.

Appeal No. 2006-1060
Application No. 10/691,060

DECISION

The rejection of claims 1-4, 7-9, 12, 14-17 and 20-23 and 25-41 under 35 U.S.C. § 102(e) over Rivette is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

TERRY J. OWENS
Administrative Patent Judge)
)
)
)
STUART S. LEW)
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES
)
)
)
ROBERT E. NAPPI)
Administrative Patent Judge)

tjo/vsh

Appeal No. 2006-1060
Application No. 10/691,060

ZILKA-KOTAB, PC
P.O. BOX 721120
SAN JOSE, CA 95172-1120

Auto-Reply Facsimile Transmission COPY

TO: Fax Sender at 4089714660

Fax Information
Date Received: 5/23/2006 5:48:36 PM [Eastern Daylight Time]
Total Pages: 6 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received Cover Page ==========>

MAY. 23. 2006 2:55PM ZILKA-KOTAB, PC NO. 3532 2.

TO: USPTO

ZILKA-KOTAB
PC
ZILKA, KOTAB & PEDOW

150 PARK CENTER PLAZA, SUITE 300
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
FAX (408) 971-4660

FAX COVER SHEET

Date: May 23, 2006	Phone Number	Fax Number
To: Board of Patent Appeals & Interferences		(571) 272-8300
From: Kevin J. Zilka		

Docket No.: SVIPF0003A

App. No: 10/691,060

Total Number of Pages Being Transmitted, Including Cover Sheet: 06

Message:

Please deliver to the Board of Patent Appeals & Interferences.

Thank you,

Kevin J. Zilka

☐ Original to follow Via Regular Mail X Original will Not be Sent ☐ Original will follow Via Overnight Courier

IF YOU DO NOT RECEIVE ALL PAGES OR IF YOU ENCOUNTER ANY OTHER DIFFICULTY, PLEASE PHONE Erica AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE